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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,702	11/19/1999	JAMES P. DOURISH	XER-2-299	7610

7590 11/10/2003

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/443,702

Applicant(s)

DOURISH, JAMES P.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Amendment A filed 08/28/2003.
2. Claims 1-20 are currently pending in this application. Claims 2, 9, 18 and 20 have been amended. Claims 1, 10, and 19 are independent claims.

Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1-8 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by **Levine et al.** (U.S. 6,167,439 – filed 11/1993).

As to independent claim 1, Levine discloses a method of providing an active annotation mechanism for use in association with a document of a document management system, where the document has an annotation added (*a document to be annotated may be chosen from the user's system desk...Annotations may be made as with any other document through the stylus, keyboard and audio input/output assembly; col. 4, lines 3-30*), the method comprising:

- electronically scanning the document (*scanning the document into the system; col. 8, lines 44-49*);

- detecting the annotation added to the scanned document (*the document to be annotated ... the currently running program is temporarily stopped ... the view from that program being displayed at the time becomes the document to be annotated; col.3, lines 25-58*);

- determining an action to be undertaken with reference to the document, based on the annotation; and performing the action required by the annotation (*provides a limited number of optional actions that the user select ... the "playback" option displays the initial form of the current document at its original followed by a time sequence of the annotations made to the document up through and including the present annotation session; col.5, lines 22-44*).

As to dependent claim 2, Levine discloses the active annotation mechanism is configured to be aware of a nature of the of the annotation content and applications whose behavior needs to be coordinated (*x-y coordinates; col.6, lines 53-63 & x- and y-axis; col.14, lines 34-53*) to perform the action required by the annotation (*col.5, lines 22-44*).

As to dependent claim 3, Levine discloses the active annotation mechanism is invoked when the document is stored (*col.6, lines 33-63*).

As to dependent claim 4, Levine discloses the active annotation mechanism is invoked at predetermined time intervals (*col.6, lines 33-42*).

As to dependent claim 5, Levine discloses the annotation carries at least one of an activity to be carried out and a parameter that configures that activity.

As to dependent claim 6, Levine discloses the annotation is stored with the document (*Annotations may be made as with any other document; col.4, lines 17-30*).

As to dependent claim 7, Levine discloses the annotation is stored separate from the document (*col.26, lines 37-67*).

As to dependent claim 8, Levine discloses the active annotation mechanism operates over at least plain text, files, program source code and presentations (*col.19, lines 20-52 & col.21, lines 13-32*)).

Independent claim 19 is directed to an active annotation mechanism for performing the method of claim 1, and is similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of **Covington et al.** (U.S. 5,524,193 – filed 09/1994).

As to independent claim 10, the rejection of claim 1 above is incorporated herein in full. However, claim 10 further recites “assigning a triggering event to the property such that the property invokes the executable code in response to the triggering event; and upon an occurrence of the triggering event, invoking the executable code of the property and dynamically changing the system configuration of the document to include the desired configuration.”

Levine is silent on these limitations.

Covington teaches assigning a triggering event to the property such that the property invokes the executable code in response to the triggering event; and upon an occurrence of the

triggering event, invoking the executable code of the property and dynamically changing the system configuration of the document to include the desired configuration (create a sequence of media events...a sequence of media events is connected will be referred to herein as a "trigger"...the ability to change existing annotating sequences; col.2, lines 42-59).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Covington with Levine because it would have provided the improved method for annotating a text document or other media event with any other media event or events.

Dependent claims 11-17 include the same limitations as in claims 2-8, and are similarly rejected under the same rationale.

5. Claims 9, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of **Applicant's Admitted Prior Art (APA)**.

As to dependent claim 9, Levine does not explicitly disclose "the annotation is placed on the document at least one of an in-line annotation and an out-of-band annotation."

APA discloses the annotation is placed on the document at least as an in-line annotation and an out-of-band annotation (Annotations are provided in a variety of ways, including but not limited to in-line annotation, or out-of-band annotations; Specification, page 1).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Levine because it would have provided the enhanced capability for adding comments to a document.

Dependent claims 18 & 20 include the same limitations as in claim 9, are similarly rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed 08/28/2003 have been fully considered but are moot in view of the new ground(s) of rejection.

Responsive to arguments set forth in Applicant's declaration (paper # 5), the Examiner has considered and removed Cullen reference used in the previous office action.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Art Unit: 2176

Contact Information:

Any response to this action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.


OFFICIAL faxes must be signed and sent to (703) 872-9306.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
October 29, 2003


SANJIV SHAH
PRIMARY EXAMINER